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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,738	04/05/2001	Steven Thomas Winkler	7781.0209-00	6058
22852	7590	04/12/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			BAUM, RONALD	
			ART UNIT	PAPER NUMBER
			2136	

DATE MAILED: 04/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,738

Applicant(s)

WINKLER ET AL.

Examiner

Ronald Baum

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in reply to applicant's correspondence of 11 February 2006.
2. Claims 23-36 are pending for examination.
3. Claims 23-36 are rejected.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 February 2006 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 23-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Greco et al,

U.S. Patent No. US 2002/0120680 A1.

5. As per claim 23; "A computer-implemented method for electronic signing an electronic document, the method comprising:

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presenting an electronic document to user [figures 4-5d and associated descriptions, paragraphs 0009-0016, 0028-0046, 0051-0063, 0065-0075, whereas the use of a document preparation application and associated GUI to select document objects (i.e., text, images, audio files, etc.) for electronic document services processing via a secure transfer, clearly encompasses the claimed limitations as broadly interpreted by the examiner.];

receiving an indication from the user as to whether the user wishes to

electronically sign all or part of the electronic document [figures 4-5d and associated descriptions, paragraphs 0009-0016, 0028-0046, 0051-0063, 0065-0075, 0098-0101, page 9, claims 19, 38, 39, whereas the use of a document preparation application and associated GUI to select document objects (i.e., text, images, audio files, etc., inclusive of object inherency aspects which deal with the piecemeal aspects of a document manipulation/processing) for electronic document services (i.e., electronic signature/signing/authentication services) processing via a secure transfer, clearly encompasses the claimed limitations as broadly interpreted by the examiner.];

if the user wishes to sign all or part of the electronic document,

determining which of a plurality of electronic signature services is to be used [figures 4-5d and associated descriptions, paragraphs 0009-0016, 0028-0046, 0051-0063, 0065-0075, 0098-0101, page 9, claims 19, 38, 39, whereas the use of a document preparation application and associated GUI to select document objects (i.e., text, images, audio files, etc., inclusive of object inherency aspects which deal with the piecemeal aspects of a document manipulation/processing) for electronic document services (i.e.,

electronic signature/signing/authentication services) processing via a secure transfer, clearly encompasses the claimed limitations as broadly interpreted by the examiner.]; and signing all or part of the electronic document using the determined electronic signing service [figures 4-5d and associated descriptions, paragraphs 0009-0016, 0028-0046, 0051-0063, 0065-0075, 0098-0101, page 9, claims 19, 38, 39, and more particularly 0032-0033, 0039, 0042, 0063, 0065, 0072, whereas the use of a document preparation application and associated GUI to select document objects for electronic document services (i.e., electronic signature/signing/authentication services) processing via a secure transfer, clearly encompasses the claimed limitations as broadly interpreted by the examiner.].”.

And further as per claim 30, this claim is an apparatus claim for limitations from the method claim 23 above, and is rejected for the same reasons provided for the claim 23 rejection.

6. Claim 24 *additionally recites* the limitations that; “The method of claim 23, wherein the electronic signing service to be used is determined based on user information.”.

The teachings of Greco et al (figures 4-5d and associated descriptions, paragraphs 0009-0016, 0028-0046, 0051-0075, 0098-0101, page 9, claims 19, 38, 39, and more particularly 0032-0033, 0039, 0042, 0063, 0065, 0072, whereas the use of a document preparation application and associated GUI to select document objects for electronic document services (i.e., electronic signature/signing/authentication services) processing via a secure transfer, such that in the case

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of E-Mail/Overnight Courier and other multiparty document transfers the sender and recipient are selected/determined per se, clearly encompasses the claimed limitations as broadly interpreted by the examiner.) suggest such limitations.

And further as per claim 31, this claim is an apparatus claim for limitations from the method claim 24 above, and is rejected for the same reasons provided for the claim 24 rejection.

7. Claim 25 *additionally recites* the limitations that; "The method of claim 23, wherein the electronic signing service to be used is determined based on
an intended recipient."

The teachings of Greco et al (figures 4-5d and associated descriptions, paragraphs 0009-0016, 0028-0046, 0051-0075, 0098-0101, page 9, claims 19, 38, 39, and more particularly 0032-0033, 0039, 0042, 0063, 0065, 0072, whereas the use of a document preparation application and associated GUI to select document objects for electronic document services (i.e., electronic signature/signing/authentication services) processing via a secure transfer, such that in the case of E-Mail/Overnight Courier and other multiparty document transfers the sender and recipient are selected/determined per se, clearly encompasses the claimed limitations as broadly interpreted by the examiner.) suggest such limitations.

And further as per claim 32, this claim is an apparatus claim for limitations from the method claim 25 above, and is rejected for the same reasons provided for the claim 25 rejection.

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8. Claim 26 *additionally recites* the limitations that; “The method of claim 23, wherein presenting the electronic document to the user further comprises:
- presenting the electronic document to the user in
 - a first format;
 - allowing the user to request presentation of the electronic document in
 - a second format,
 - wherein the second format is determined by
 - an intended recipient of the electronic document
 - after signature”.

The teachings of Greco et al (figures 4-5d and associated descriptions, paragraphs 0009-0016, 0028-0046, 0051-0075, 0098-0101, page 9, claims 19, 38, 39, and more particularly 0032-0033, 0039, 0042, 0063, 0065, 0072, whereas the use of a document preparation application and associated GUI to select document objects (in the inherently varying formats (first, second, etc.,) of the various document preparation application object manipulation functionality; pre and post electronic document servicing) for electronic document services (i.e., electronic signature/signing/authentication services) processing via a secure transfer, such that in the case of E-Mail/Overnight Courier and other multiparty document transfers the sender and recipient are selected/determined per se, clearly encompasses the claimed limitations as broadly interpreted by the examiner.) suggest such limitations.

And further as per claim 33, this claim is an apparatus claim for limitations from the method claim 26 above, and is rejected for the same reasons provided for the claim 26 rejection.

9. Claim 27 *additionally recites* the limitations that; “The method of claim 26, wherein presenting the electronic document to the user further comprises:
- selecting one or more elements from
- the electronic document; and
- displaying the one or more selected data elements in
- the second format to the user”.

The teachings of Greco et al (figures 4-5d and associated descriptions, paragraphs 0009-0016, 0028-0046, 0051-0075, 0098-0101, page 9, claims 19, 38, 39, and more particularly 0032-0033, 0039, 0042, 0063, 0065, 0072, whereas the use of a document preparation application and associated GUI to select document objects (in the inherently varying formats (first, second, etc.,) of the various document preparation application object manipulation functionality; pre and post electronic document servicing) for electronic document services (i.e., electronic signature/signing/authentication services) processing via a secure transfer, such that in the case of E-Mail/Overnight Courier and other multiparty document transfers the sender and recipient are selected/determined per se, clearly encompasses the claimed limitations as broadly interpreted by the examiner.) suggest such limitations.

And further as per claim 34, this claim is an apparatus claim for limitations from the method claim 27 above, and is rejected for the same reasons provided for the claim 27 rejection.

10. Claim 28 *additionally recites* the limitations that; “The method of claim 27, wherein

the one or more selected data elements are

displayed to the user in

the second format with additional text.”.

The teachings of Greco et al (figures 4-5d and associated descriptions, paragraphs 0009-0016, 0028-0046, 0051-0075, 0098-0101, page 9, claims 19, 38, 39, and more particularly 0032-0033, 0039, 0042, 0063, 0065, 0072, whereas the use of a document preparation application and associated GUI to select document objects (in the inherently varying formats (first, second, etc.,) of the various document preparation application object manipulation functionality; pre and post electronic document servicing) for electronic document services (i.e., electronic signature/signing/authentication services) processing via a secure transfer, such that in the case of E-Mail/Overnight Courier and other multiparty document transfers the sender and recipient are selected/determined per se, clearly encompasses the claimed limitations as broadly interpreted by the examiner.) suggest such limitations.

And further as per claim 35, this claim is an apparatus claim for limitations from the method claim 28 above, and is rejected for the same reasons provided for the claim 28 rejection.

11. Claim 29 ***additionally recites*** the limitations that; “The method of claim 27, wherein

the one or more selected data elements comprise

contractual terms and

the additional text comprises

language of a contract.”.

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The teachings of Greco et al (figures 4-5d and associated descriptions, paragraphs 0009-0016, 0028-0046, 0051-0075, 0098-0101, page 9, claims 19, 38, 39, and more particularly 0032-0033, 0039, 0042, 0063, 0065, 0072, whereas the use of a document preparation application and associated GUI to select document objects (in the inherently varying formats of the various document preparation application object manipulation functionality; pre and post electronic document servicing) for electronic document services (i.e., electronic signature/signing/authentication services) processing via a secure transfer, such that in the case of E-Mail/Overnight Courier and other multiparty document transfers the sender and recipient are selected/determined/bound by contract (as to the various aspects of the document transfer), clearly encompasses the claimed limitations as broadly interpreted by the examiner.) suggest such limitations.

And further as per claim 36, this claim is an apparatus claim for limitations from the method claim 29 above, and is rejected for the same reasons provided for the claim 29 rejection.

Transitional provisional application reference

Copy of Provisional Application(s) Relied Upon for Prior Art Effect May Not be Supplied

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application

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is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge will not apply.

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Conclusion

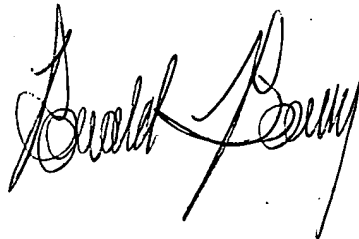
12. Any inquiry concerning this communication or earlier communications from examiner should be directed to Ronald Baum, whose telephone number is (571) 272-3861, and whose unofficial Fax number is (571) 273-3861. The examiner can normally be reached Monday through Thursday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh, can be reached at (571) 272-3795. The Fax number for the organization where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. For more information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronald Baum

Patent Examiner

A handwritten signature in black ink, appearing to read "Ronald Baum", written in a cursive style.